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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/695,437	10/24/2000	Carl W Anderson	BSA 01-02	2813

7590

03/25/2003

Margaret C Bogosian  
Patent Counsel  
Brookhaven National Laboratory  
BLDG 475D PO BOX 5000  
Upton, NY 11973-5000

EXAMINER

PROUTY, REBECCA E

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 03/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/695,437

Applicant(s)  
Anderson et al.

Examiner  
Rebecca Prouty

Art Unit  
1652



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-111 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-111 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-22 and 97-98 drawn to methods of detecting DNA-activated protein kinase (DNA-PK), classified in class 435, subclass 15.
- II. Claims 23-52 and 99-105, drawn to peptide substrates of DNA-PK, classified in class 500, subclass 300.
- III. Claims 53-63, drawn to methods of detecting DNA, classified in class 435, subclass 6.
- IV. Claims 64-77 and 106-111 drawn to methods of detecting modulators of DNA-PK, classified in class 435, subclass 15.
- V. Claims 78-83, drawn to methods of detecting protein phosphatase, classified in class 435, subclass 21.
- VI. Claims 84-87, drawn to methods of monitoring protein kinase activity in a cell, classified in class 435, subclass 6.
- VII. Claims 88-92, drawn to expression vectors encoding a DNA-PK substrate, classified in class 435, subclass 320.1.
- VIII. Claims 93-94, drawn to methods of detecting modulators of protein kinase in a cell, classified in class 435, subclass 6.

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IX. Claims 95-96, drawn to methods of monitoring protein kinase activity in a cell, classified in class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I, III or IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the peptides of Group II could be used as an affinity ligand for purification of DNA-PK.

The methods of Groups I, III, IV-IV, VIII and IX are patentably distinct as they comprise unrelated steps, use different products and produce different results.

The DNA of Group VII is unrelated to the methods of Groups I and III-V as it is neither used nor made by the methods of Groups I and III-V.

The peptides of Group II are unrelated to the methods of Groups V, VI, VIII and IX as they are neither used nor made by the methods of Groups V, VI, VIII and IX.

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The DNA of Group VII and the peptides of Group II are patentably distinct compounds because they are chemically different, the DNA has other utility besides encoding the peptides such as a hybridization probe and the peptides can be made by another method such as chemical synthesis.

Inventions VII and VI, VIII or IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the DNA can be used as a hybridization probe.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter as shown by their different classification, restriction for examination purposes as indicated is proper.

All claims are generic to a plurality of disclosed patentably distinct species comprising the DNA-PK peptide substrates or vectors encoding the peptide substrates of SEQ ID NOS: 1-4, 6-8, 11, 12, 14-19, 63 and 64 or methods of using these peptides or vectors. Each of these peptide substrates is

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patentably distinct as having a distinct chemical structure, each separate structure requiring an independent search. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

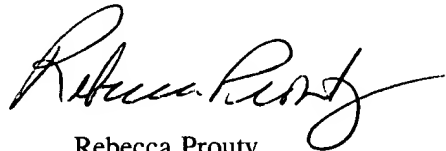
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rebecca Prouty, Ph.D. whose telephone number is (703) 308-4000. The examiner can normally be reached on Monday-Friday from 8:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, can be reached at (703) 308-3804. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

A handwritten signature in black ink, appearing to read 'Rebecca Prouty', with a stylized flourish at the end.

Rebecca Prouty  
Primary Examiner  
Art Unit 1652